

**REMARKS**

Claims 1-9 are pending in this application. The Examiner maintains his previous prior art rejections:

- claims 1-4 and 9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Sakurai et al. (Sakurai); and
- claim 6 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Sakurai in view of Inoue (U.S. patent No. 6,337,978 assigned to Mitsubishi).

The Examiner again indicates that claims 5, 7 and 8 would be **allowable** if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Applicant respectfully traverses the Examiner's prior art rejections as follows.

As noted in Applicant's previous Amendment, filed January 30, 2004, Applicant's invention provides DSRC car-mounted equipment, which communicates with on-the-road equipment, comprising unique combinations of features including, *inter alia*, a reception sensitivity-increasing means for increasing reception sensitivity in response to the entrance into a communication area with on-the-road equipment, "wherein the reception sensitivity-increasing means returns the reception sensitivity back to the normal reception sensitivity of before entering into communication start area in response to the end of communication with the on-the-road equipment" (see claim 1).

As explained in great detail in Applicant's previous Amendment, changing reception sensitivity, as claimed in claim 1, has nothing to do with changing power consumption mode, as described in Sakurai (the Examiner's primary reference).

That is, Sakurai discloses a vehicle-mounted device 10 provided with “an electric field-strength detecting circuit 5 to detect when the field strength of radio waves emitted from the roadside device reaches or exceeds the threshold value ..., and outputs an activating signal when the field strength reaches or exceeds a threshold value” (see *Id.*, col. 3, lines 43-52). Vehicle-mounted device 10 includes a control circuit 4 which operates “at a low-power consumption mode until an activation signal is output from [circuit 5],” and actuates amplifier/demodulator 3 to begin communication with a roadside device in response to the “activation signal” (see *Id.*, col. 3, line 53 through col. 4, line 9).

The Examiner relies on an “inherency” theory, alleging that, in Sakurai’s vehicle-mounted device 10 reception sensitivity increases when switching from low power-consumption mode to normal power-consumption mode. In support of this theory, the Examiner cites col. 3, line 64 through col. 4, line 3 of Sakurai. This portion of Sakurai is reproduced below in its entirety:

When operating in the low power-consumption mode, the control circuit 4 assumes a sleep state without actuating the amplifier/demodulator 3. When an activating signal is output from the comparator 51 and the normal power-consumption mode is enabled, the control circuit 4 actuates the amplifier/demodulator 3 and begins communication with the roadside device. (*Id.*)

Based on the foregoing disclosure of Sakurai, the Examiner concludes that, “[i]t is, at the very least, implicit from these teachings that during the low power mode (i.e., when the device 10 is not in a communication area with the roadside device) the reception sensitivity is low (because amplifier/demodulator 3 is deactivated) and during the normal power mode (i.e., when

the device 10 is in a communication area with the roadside device) the reception sensitivity is higher (because amplifier/demodulator 3 is activated)” (see Office Action, page 9). Applicant respectfully disagrees.

Sakurai’s Fig. 1 is block schematic diagram of a circuit in Sakurai’s vehicle-mounted device 10 that performs communication with a roadside device. This diagram clearly illustrates that, neither the “wave detection circuit 2”, nor the “field-strength detector 5 [which] detects when the vehicle-mounted device 10 enters an area of communication with a roadside device”, is in any way affected by the activation and/or deactivation of the “amplifier/demodulator 3” (see *Id.*, col. 3, lines 43-52). In fact, nowhere does Sakurai disclose, teach or suggest that reception sensitivity of its device 10 is somehow related to power consumption mode of operation of its “control circuit 4”, or to the activation/deactivation of its “amplifier/demodulator 3” .

Thus, the Examiner’s “inherency” argument lacks any support in the prior art (e.g., the Sakurai patent), and is contrary to well established legal principles. *See Tyler Refrigeration v. Kysor Industrial Corp .*, 777 F.2d 687, 689 (Fed. Cir. 1985) (“A feature is inherent if it **naturally occurs** under the conditions set forth in the reference, even though the reference does not expressly mention the feature”, emphasis added). The Examiner simply states that, in Sakurai it is “implicit” that the reception sensitivity is low because amplifier/demodulator 3 is deactivated, and vice-versa (see Office Action, page 9), without providing any rationale as to how in Sakurai’s circuit shown in Fig. 1, activation and/or deactivation of amplifier/demodulator 3 **necessarily** affects reception sensitivity of device 10 (where sensitivity is based on the operation of detection wave circuit 2 and field wave detection circuit 5, and is not affected by

amplifier/demodulator 3), in a manner proposed by the Examiner. *See Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Int.) (“In relying upon theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art”, original emphasis).

Thus, Applicant’s independent claim 1, as well as its dependent claims 2-5 and 9 (which incorporate all the novel and unobvious features of their base claim 1), would not have been obvious from Sakurai.

With regard to dependent claim 6, as noted in Applicant’s previous Amendment, Inoue does not supply the above-noted deficiencies of Sakurai. Therefore, claim 6 would not have been obvious from any reasonable combination of Sakurai and Inoue at least for the reasons set forth above with regard to claim 1.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned attorney at the telephone number listed below.

Response Under 37 C.F.R. § 1.116  
U.S. Appln No. 09/635,636

Atty Dkt No. Q60126

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

**23373**

CUSTOMER NUMBER

Date: August 26, 2004

Respectfully submitted,



Stan Torgovitsky  
Registration No. 43,958